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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,653	10/21/2003	Shiping Wang	GL-6171	5864

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EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,653

Applicant(s)

WANG ET AL.

Examiner

Kevin M Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/27/04; 4/11/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group II, claims 18 - 36 in the reply filed on March 31, 2005 is acknowledged.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry (U.S. Patent No. 5,869,072) in view of Mansouri (U.S. Patent App. No. 2001/0006680 A1) and Murray et al. (U.S. Patent No. 4,920,158), and further supported by applicants' admissions.

Regarding claims 18, 23, 24, 34 and 35, Berry discloses an elastomeric article in the form of a glove (*Figure 1*) comprising a coating composition on the skin-contacting surface (*col. 3, lines 36 – 47*), said coating composition being in dry state (*col. 3, lines 60 – 64*) and comprising at least one moisturizer (*col. 7, lines 27 – 30*) and wherein said composition is water-soluble and hydratable upon contact with skin (*col. 3, lines 60 – 64*). The limitation(s) "examination glove" and "surgeon's glove" are (an) intended use limitation(s) and are not further limiting in so far as the structure of the product is

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concerned. Note that “in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02.

Berry fails to disclose the coating composition comprising polyhydric alcohol as the moisturizer, nor at least one alphahydroxy lactone, though Berry does disclose adding propylene glycol (*col. 7, lines 31 – 33*) to the coating composition.

However, the Examiner deems that Aloe vera and pantothenol (i.e. a polyhydric alcohol) are known equivalents in the field of moisturizers/anti-inflammatory agents, as taught by Mansouri (*Paragraphs 0118 and Examples – the Examiner notes that pantothenol and panthenol are interchangeable, see applicants’ specification, page 5, lines 20 - 21 and page 15, lines 9 - 10*). Furthermore, the Examiner deems that propylene glycol and gluconolactone (i.e. an alphahydroxy lactone) are known equivalents in the field of plasticizers added to skin coating compositions, as taught by Murray et al. (*col. 6, lines 3 – 9 and examples*).

Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. In the instant case, pantothenol and gluconolactone versus aloe vera and propylene glycol, respectively, are equivalents in the field of

moisturizers/anti-inflammatory agents and plasticizers in the field of skin coating compositions. *In re Fount* 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* 85 USPQ 328 (USSC 1950).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Berry to utilize a coating composition meeting applicants' claimed limitations as taught by Mansouri and Murray et al., since such a composition requires mere substitution of known equivalent functional materials, which is within the knowledge of one of ordinary skill in the art of skin coating compositions.

Regarding claims 19 - 22, the Examiner takes official notice that the claimed materials are well known materials used for formation of gloves.

Regarding claim 25, the Examiner notes that Mansouri teaches that panthenol can be provided in vitamin form, which the Examiner deems would be obvious to one of ordinary skill in the art since the pantothenol would then function as both a moisturizer and a vitamin. The Examiner notes that the pantothenol *is* the provitamin B form (see *applicants' specification, page 10, lines 1 - 18*).

Regarding claims 26 and 27, Murray et al. disclose gluconolactone meeting applicants' claimed limitations (*col. 7, lines 27 – 29 and col. 12, lines 36 - 39*).

Regarding claim 28, Murray et al. disclose using sorbitol in combination with the gluconolactone (*col. 7, lines 27 – 29 and examples*) and Mansouri teach using glycerin as a humectant in the coating composition (*Paragraph 0147*).

Regarding claims 29, 30 and 36, Murray et al. teach adding chitin as a drying aid to skin coating compositions. The Examiner notes that "chitosan" is a known equivalent derivative of "chitin" (see additional rejection of claims 30 and 36 below for support of the Examiner's position).

Regarding claim 31, Berry discloses adding a hydration promoter (*col. 7, lines 17 – 20*).

Regarding claim 32, Murray et al. teach preferably using a combination of glycerol, sorbitol and gluconolactone as plasticizers, hence reading on the claimed limitations of at least one alphahydroxy lactone in combination with a plasticizer (*col. 7, lines 27 – 29*).

Regarding claim 33, Berry discloses adding the moisturizer (i.e. the pantothenol) and plasticizer propylene glycol (i.e. the gluconolactone) in amounts meeting applicants' claimed weight percents (*col. 7, lines 27 – 33*).

4. Claims 19 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Mansouri and Murray et al. as applied above, and further in view of Dresdner, Jr. et al. (U.S. Patent No. 5,357,636).

Berry, Mansouri and Murray et al. are relied upon as described above.

None of the above explicitly disclose making gloves out of the claimed materials.

However, Dresdner, Jr. et al. teach that it is known in the art to form surgeon's and examination gloves out of the claimed materials (*col. 18 and col. 23*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Berry in view of Mansouri and Murray et al. to form the gloves out of the claimed materials as taught by Dresdner, Jr. et al. since such materials are well known in the art as suitable materials for forming stretchable/flexible medical gloves.

5. Claims 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Mansouri and Murray et al. as applied above, and further in view of Bazin et al. (U.S. Patent No. 6,001,367).

Berry, Mansouri and Murray et al. are relied upon as described above.

None of the above explicitly disclose using chitosan instead of chitin.

However, the Examiner deems that chitosan and chitin are known equivalents in naturally occurring polymers for use in skin coating compositions, as taught by Bazin et al. (*col. 3, line 64 bridging col. 4, line 6*).

Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. In the instant case, chitin and chitosan are equivalents in the field of naturally occurring polymers for use in skin coating compositions.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pearson et al. (U.S. Patent No. 6,261,589 B2) teach that panthenol is known to be provitamin B-5 (*col. 3, line 66*).

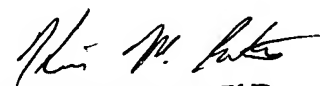
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
June 23, 2005

  
**Kevin M. Bernatz, PhD**  
**Primary Examiner**